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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,038

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Josef Schneider

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27799

7590

10/26/2009

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EXAMINER

EVANISKO, LESLIE J

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,038	<b>Applicant(s)</b> SCHNEIDER ET AL.	
	<b>Examiner</b> Leslie J. Evanisko	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| Paper No(s)/Mail Date _____  | 6) <input checked="" type="checkbox"/> Other: <u>partial English translation of JP 08-290543 A</u> |

## **DETAILED ACTION**

Please note that this application is now being examined by Examiner Leslie Evanisko and all future correspondence in this application should reference her as the Examiner of this application.

### **Election/Restrictions**

1. Claims 19-31 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 16, 2009.

### **Priority**

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on January 15, 2004. It is noted, however, that the copy of the certified priority document is not present in the application file. The Examiner has requested the copy of the certified copy of the priority document and will notify applicant of the outcome when that information becomes available.

### **Drawings**

3. The replacement sheet of drawings was received on July 13, 2006. This drawing is objected to for the reasons set forth below.

4. The drawings are objected to because of the following informalities:

It is noted that there is only one Figure present in the application that has been labeled as “Fig. 1.” However, note that 37 CFR 1.84(u)(1) states, “Where only a single view is used in an application to illustrate the claimed invention, it must **not** be numbered and the abbreviation “FIG.” must **not** appear.” Therefore, it is suggested that the label “Fig. 1” be deleted from the one sheet of drawings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Objections**

5. Claim 37 is objected to because of the following informalities:

With respect to claim 37, the term “said plural data streams” in line 1 has no proper antecedent basis since only “a plurality of data streams” was previously recited. Note that consistent terminology should be used throughout the claims. Therefore, it is suggested that the term “plural” in line 1 of claim 37 be deleted and replaced with -- plurality of-- to use consistent language.

Appropriate correction and/or clarification is required.

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumaru et al. (JP 08-290543 A) in view of Fuhrmann et al. (US 6,631,677 B1).

With respect to claim 32, Katsumaru et al. teach a device for printing on a substrate, the device comprising at least one printing unit B, B1 configured to print a static or unchanging image on the substrate 1, at least one printing device 9, installed inline with the at least one printing unit B, B1, and configured to individualize the static image by adding at least one dynamic or changing image to the substrate, each the at least one printing device 9 used to print at least one dynamic or changing image receiving a data stream (via controller 10) containing data for the at least one dynamic or changing image; wherein the image information is printed inline of the substrate in a single workflow. See, in particular, Figure 1 and the attached partial English language translation. Katsumaru et al. is silent with respect to the details of how the static or unchanging image is formed in the printing unit and whether the unit is configured to receive a data stream containing data for the static or unchanging image. However, printing units configured to receive data for the static or unchanging image and to perform in-press imaging of the print drum are well known in the art as exemplified by the press of Fuhrmann et al. In view of this teaching, it would have been obvious to provide the printing unit of Katsumaru et al. to be configured to receive a data stream containing data for the static or unchanging image as taught by Fuhrmann et al. to allow for a more versatile printing device that is capable of in-press imaging of the plate drum.

With respect to claim 33, note the printing unit for the static or unchanging image of Katsumaru et al. is an offset press B, B1 as shown in Figure 1 and described in paragraph [0010] of the attached partial English language translation.

With respect to claim 34, note the printing device for the dynamic or changing image in Katsumaru et al. is an ink-jet printer 9 as shown in Figure 1 and described in paragraph [0010] of the attached partial English language translation.

With respect to claim 35, Katsumaru et al. in view of Fuhrmann et al. teach a device as recited with the exception of the at least one printing device used to print the dynamic or changing image being based on the principle of electrophotography, magnetography, electrocoagulation, or ionography. However, the use of these various types of digital printing devices to print image information is well known in the art. In view of this, it would have been obvious to one of ordinary skill in the art to provide at least one printing device based upon the principle of electrophotography, magnetography, electrocoagulation or ionography in the device of Katsumaru et al. in view of Fuhrmann et al. as it would simply require the obvious substitution of one known digital image printing device for another. Furthermore, the system of Katsumaru et al. in view of Fuhrmann et al. would perform equally well with a printing system based upon electrophotography, magnetography, electrocoagulation, or ionography instead of an inkjet printing device to provide the dynamic or changing image on the substrate.

With respect to claim 36, note the device of Katsumaru et al. in view of Fuhrmann et al. can broadly be considered to include a control unit that can broadly be considered to be either “open-loop” or “closed-loop” as recited.

With respect to claim 37, note the device of Katsumaru et al. as modified by Fuhrmann et al. would inherently include at least three data streams. In particular, note Katsumaru et al. teaches the device can include a plurality of inkjet heads (see

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paragraph [0015]) and there would clearly be a data stream of image information required for each inkjet head. Furthermore, note the printing unit of Katsumaru et al. as modified by Fuhrmann et al. is a double-sided print unit and therefore would require multiple data streams of image information in order for each plate cylinder to be imaged. Thus, the device of Katsumaru et al. in view of Fuhrmann et al. includes three data streams as recited.

### **Response to Arguments**

9. Applicant's arguments with respect to claims 32-37 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watanabe et al. (US 6,070,525), Sato (US 2005/0217520 A1), and Pscheidl (DE 197 04 003 A1) each teach a device for printing with both inkjet and another type of printing having obvious similarities to the claimed subject matter.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*/Leslie J. Evanisko/*  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
October 24, 2009